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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,675	08/06/2001	Michael W. Wood	MOODY 20	1529

24258 7590 06/09/2003

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,675

Applicant(s)

WOOD ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: BET MAX location 28 (page 8, line 5). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, Jr. et al. (US Patent No. 5,957,774) in view of Falciglia (US Patent No. 5,935,002).

Holmes, Jr. et al. disclose a method of playing a video poker game having a bonus award associated with the poker game (Abstract). A predetermined arrangement of five cards (FIG 1-A, reference 220) is established as a winning bonus award and is thus used as the player's matching cards for the game (Column 3, lines 45-51). Holmes, Jr. et al. also contemplate the use of the predetermined arrangement of cards based upon the Royal Flush, as the Royal Flush typically represents the highest payout (thus has the least likelihood) for poker (Column 1, lines 57-67; Column 2, lines 14-17). The player is then dealt a first initial five-card hand (Column 3, line 47) and it is determined whether any of the first initial five cards match any of the predetermined cards (Column 3, lines 48-51). After the initial five cards are analyzed to determine if a win has occurred on the deal, the player is then allowed to play out the first initial five card hand according to the convention rules of poker (Column 3, lines 7-12). Holmes, Jr. et al. also disclose that the player must make a wager in order to be eligible to participate in the game (Column 1, lines 24-26).

Holmes, Jr. et al. do not disclose noting the matched cards as they occur or continuing to deal subsequent hands and allowing the player to play out each of the subsequent hands in order to continue trying to match cards with the predetermined arrangement.

However, Falciglia discloses a method wherein a player plays multiple hands of a game in an attempt to achieve a match in a predetermined arrangement of numbers in order to win a secondary award (Column 3, lines 50-67). The player receives the number in the base game and if it matches one of the predetermined numbers selected and displayed above (Column 5, lines 30-33), the match is noted by covering up or highlighting the space (Abstract). When all of the predetermined arrangement of spaces have been matched, it will be determined the bonus award

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which will be awarded to the player (Column 6, lines 11-23). By allowing the player a number of spins in order to attain the required predetermined arrangement, the method of Falciglia increases excitement in that the player will be more inclined to continue to pay for games as they feel the increasing cost will lead to a payout. Falciglia also teaches of basing the award received in the secondary game on the number of tries that it took for all of the predetermined arrangement of cards to be matched (Column 6, lines 11-23). These payouts are based on a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13). Regarding claim 5, Falciglia does not disclose the exact payable as claimed; however, it is notoriously well known in the art to adjust pay tables for a variety of reasons including attempts to attract players with high payouts and payouts that would allow the player to perceive a greater chance of winning an award. It would have been obvious to one of ordinary skill in the art to do so and make adjustments to pay tables as long as the payable keeps the appropriate house advantage while remaining fair to the player and provide a proper balance between winning, losing, and investing for each spin as disclosed as desirable for a winnings schedule by Falciglia.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Falciglia into the system of Holmes, Jr. et al. By incorporating multiple chances for the player to accumulate the numbers needed for matching the winning hand and a payable based upon the number of chances used to achieve the winning hand, as taught by Falciglia, the method of Holmes, Jr. et al. would provide the player with a greater sense of the possibility of a winning outcome. One would be motivated to make this incorporation as by continuing to deal subsequent five card hands and determining further

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matches based upon further hands, in order to extend the game of Holmes, Jr. et al., player anticipation, excitement, and belief of an award would be increased and thus would be a direct result of allowing the player to continue with the game after the initial hand by furthering the chance to build the matching hand and basing the award on the number of chances used, as disclosed by Falciglia. This increase in player interest would thus result in gained revenues for the casino.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,481,713: Game wherein the player is trying to match the face of the die with a predetermined selection and is given a number of attempts to make this match.

US Patent No. 6,549,014: Electronic gaming device and method wherein the payable is associated with the number of cards drawn in the poker game.

US Patent No. 6,569,013: Method of playing a video gambling game wherein the payable is dynamic and changes with the successive number of games played.

US Patent No. 6,390,921: Method of playing a game wherein a collect and win theme is present. Discloses that collect and win is a well known game used in the gaming industry that encourages players to play a multiplicity of times in order to collect all the needed pieces of a predetermined collection in order to match the winning set.

US Patent No. 6,164,652: Method of playing a game wherein the player is dealt cards and the objective of the game is for the player to match the cards that the dealer has in order to win.

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US Patent No. 6,227,969: Method of playing a game of poker wherein a side bet game is present and the player can wager on the chance that one or more of the cards currently dealt matches the side bet cards.

US Patent No. 6,568,680: Gaming method wherein a player can play a number of hands in a row and wager on all of the hands wherein the poker game comprises playing each initial deal out to completion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
cmm
June 3, 2003


MICHAEL O'NEILL
PRIMARY EXAMINER